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EXAMINER

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 20

Application Number: 08/825,576

Filing Date: March 31, 1997

Appellant(s): Thomas D. Petite

Thomas, Kayden, Horstemeyer & Risley
For Appellant

EXAMINER'S ANSWER

MAILED
SEP 21 1999
GROUP 2200

This is in response to appellant's brief on appeal filed on July 12, 1999.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect

or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 21-25 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,319,364 WARAKSA ET AL. 6-1994

5.550.358 TAIT ET AL. 8-1996

Wollenberg, S. "Device could speed-up visits to gas stations" The Augusta

Chronicle Online business@ugusta, 2/19/1997.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim 23 stands rejected under 35 U.S.C. § 112, first paragraph. This rejection is set forth in prior Office action, Paper No. 9.

Claims 21-23 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tait et al in view of Waraksa et al. This rejection is set forth in prior Office action, Paper No. 9.

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tait et al in view of Waraksa et al and Wollenberg. This rejection is set forth in prior Office action, Paper No. 9.

(11) *Response to Argument*

In the last three lines of page 10 and on page 11 of the brief, appellant discusses the lack of disclosure of “user identification data, including track 1 and track 2 data” by Waraksa et al. In lines 13-16 on page 16 of appellant’s specification, track 1 data is said to include a person’s name and track 2 data is said to include a person’s account number and pin (personal identification number). In the rejection of claim 21, appellant was informed that Tait et al disclosed a remote access device for accessing a financial transaction machine comprising a memory for storing user identification data, including track 1 and track 2 data. Such disclosure can be found in lines 49-55 in column 4 of Tait et al.

In the first paragraph on page 12 of the brief, appellant contends that neither Tait et al nor Waraksa et al disclose a transmitter configured to transmit user identification data (track 1 and track 2 data) in direct response to a manual depression a user button without any verification of user identification. Tait et al disclose three embodiments (10, 10A and 10B) of

a remote access device for accessing a financial transaction machine. The first two embodiments (10, 10A) have a transmitter (28, 28A) for transmitting information stored in a memory chip (20, 20A) only if the correct PIN is entered via a keypad (17, 17A). As noted in the previous paragraph the memory chip stores user identification data (track 1 and track 2 data). The first embodiment (10) is shown in Figs. 1 and 3A and described in lines 32-67 of column 4 and lines 1-52 of column 5. The second embodiment (10A) is shown in Figs 2 and 4 and described in lines 53-67 of column 5 and lines 1-4 of column 6. The third embodiment (10B) has a transmitter (28B) for transmitting information stored in a memory chip (20B) in direct response to the manual depression of a single user-depressible button (16B). The third embodiment (10B) does not have a keypad and does not require verification of user identification before transmitting the information stored in the memory. The third embodiment is shown in Fig. 5 and described in lines 5-54 of column 6. The third embodiment of the remote access device was used in the rejection of the claims as indicated in the paragraph bridging pages 3 and 4 of Paper No. 9.

In the second paragraph on page 12 of the brief, appellant contends that Tait et al and Waraksa et al are directed to non-analogous art. The Board's attention is directed to the fact that both patents are directed to wireless remote access devices. In fact, Waraksa et al was cited by appellant in an information disclosure statement filed on July 3, 1997, Paper No. 3. Appellant states in the information disclosure statement that the documents cited therein may be considered material to the examination of this application.

With respect appellant's comments in the last six lines on page 11, the last paragraph on page 13 and the first paragraph on page 14 of the brief, the Board's attention is directed to Waraksa et al. Waraksa et al disclose a coding scheme for signals transmitted by a remote

access device which improves system performance. The coding scheme comprises a plurality of synchronization bits, a function code (data), an identification code (data) and an error correction code. The code scheme is disclosed under the heading “ERROR CORRECTION CODE” in columns 5-7 of Waraksa et al. The components of the coding scheme set forth in claims 21 and 22 are not novel in the art of remote access devices as evidenced by Waraksa et al and the use of such a scheme in the remote access device of Tait et al would have resulted in improved system performance.

On pages 14-16 of the brief, appellant contends that the rejection of claim 23 under 35 U.S.C. § 112, first paragraph, is misplaced. Claim 23 is directed to a remote access device with a single user-depressible button for accessing a financial transaction machine. The controller of the remote access device of claim 23 controls the transmitter to transmit a function code that defines a function selected from the group consisting of: automatic financial transaction machine access, a test code, an automobile lock and a distress call. There is no original disclosure of a remote access device with a single user-depressible button for accessing a financial transaction machine which allows the controller of the access device to transmit a function code that defines a function selected from the group consisting of: a test code, an automobile lock and a distress call. The single button remote access device is disclosed as only transmitting a function code that defines automatic financial transaction access. To transmit a function code that defines a function selected from the group consisting of: a test code, an automobile lock and a distress call more than a single user-depressible button is required. This is evidenced by lines 4-10 on page 9 of appellant’s specification (quoted on page 15 of appellant’s brief) and lines 4-13 on page 17 of appellant’s specification. Claim 23 contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the appellant, at the time the application was filed, had possession of the invention as is now claimed.

On pages 17-19 of the brief, appellant contends that Wollenberg does not constitute prior art in that the filing date of the present application predates the publication date of Wollenberg. The Wollenberg article discloses the use of the Mobile Speedpass™ by 11,000 customers at 55 Mobil stations in St. Louis, Missouri since August 1996. The Mobil Speedpass™ is a cylinder of about an inch long and a fourth of an inch in diameter that attaches to a key ring. The operation of the Speedpass™ is described in the first full paragraph on page 2 of the article. St. Louis, Missouri was the test market for the Speedpass™ technology. In the test market, all Speedpass™ pumps were clearly identified and included customer instructions. Because of the widespread use of the Mobil Speedpass™ (a remote access device for accessing financial transaction machines) in St. Louis since August 1996, the key ring attached Speedpass™ is prior art.

With respect to appellant's statements on pages 19-21 of the brief concerning claim 25, the Board's attention is directed to the first and second paragraphs under this section of the brief.

In the first full paragraph on page 21 of the brief, appellant states that claim 25 sets forth a magnetic card reader, receiving means for receiving data from a remote access device and a network for communicating user identification data to a remote location. In lines 10-25 of column 5, Tait et al disclose a receiver (12) which receives data from a remote access device and a magnetic card reader (30). As disclosed in lines 45-52 of column 3, a telephone network is used to communicate user identification data to a remote location. Also, see lines 42-54 of column 6 and the last two steps in the flow chart in Fig. 8.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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September 20, 1999

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